



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,937	05/09/2001	Julien Tan Nguyen	139.1002.02	7225

7590 10/20/2005

RORY D. RANKIN  
MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.  
P.O. BOX 398  
AUSTIN, TX 78767-0398

EXAMINER

CHEA, PHILIP J

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/853,937	NGUYEN, JULIEN TAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Philip J. Chea	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 4-8,25-29 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-8,25-29 and 41-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2153

### **DETAILED ACTION**

This Office Action is to replace the previous First Action on the Merits mailed on May 17, 2005. Claims 4-8,25-29,41-44, are currently pending.

#### ***Priority***

1. This application filed under former 37 CFR 1.62 lacks the necessary reference to the prior application. A statement reading "This is a continuation of Application No. 08/716641, filed 9/13/1996." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of the parent nonprovisional application(s) should be included.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 5/9/01 was filed after the mailing date on 2/12/02. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
3. The IDS has already been considered from a previous Office Action.

#### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: See page 15, line 6, where element 156 is not included in the drawing.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

Art Unit: 2153

by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-8, 25-29, 41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Stratigos et al. and further in view of Judson et al (US 5,572,643).

As per claims 4, 25, 41, and 43, Brown discloses a system for presenting electronic mail messages to an operator, as claimed, including the steps of:

- loading a plurality of headers from a mail server, each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message (see page 369 Fig. 14.15, and page 370, paragraph 1);
- receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded (see page 370, *Opening and Replying to Messages*, where displaying the listings in the mailbox (Fig 14.15), and selecting a listing to open is considered a head prior to message being loaded);
- presenting said first electronic mail message to said operator (see page 370, *Opening and Replying to Messages*); and

Art Unit: 2153

- identifying a second one of said electronic mail messages for preloading (see page 369, Fig. 14.15, where a second message is identified as shown by the multiple messages in the summary window).

As to claim 25, it is similar to claim 4, 41 and 43 with the additional feature of:

- an input element coupled to said input port (see page 370, paragraph 1); and
- an output element coupled to said output port (see page 370, paragraph 1, where opening a window implies an output element),

Brown does not explicitly mention the feature of preloading said second electronic mail message for later presentation, without interrupting presentation of said first electronic mail message.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Brown, as evidenced by Stratigos et al.

In an analogous art, Stratigos et al. disclose a system for presenting electronic mail messages to an operator, including the steps of:

- preloading a second electronic mail message for later presentation, without interrupting presentation of a first electronic mail message (see column 6, lines 18-26).

Given the teaching of Stratigos et al., a person having an ordinary skill in the art would have obviously recognized the desirability and advantages of modifying Brown by preloading a second mail message without interrupting the first message, such as disclosed by Stratigos et al., in order to reduce the cost of transmission when accessing a series of documents (see Stratigos et al. column 2, lines 62-64).

Although the system disclosed by Brown in view of Stratigos shows substantial features of the claimed invention (discussed above), it fails to disclose presenting to said operator a status of said step of preloading said second electronic mail message.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Brown in view of Stratigos et al., as evidenced by Judson.

In an analogous art, Judson discloses presenting to an operator a status of preloading a second electronic message (see column 6, lines 35-39, where the inline message is shown as the hypertext

Art Unit: 2153

document is being downloaded using the status bar from Fig. 5). The document in Fig. 5 is preloading as a user is shown a welcome screen shown in Fig 8.

Given the teaching of Judson, a person having an ordinary skill in the art would have obviously recognized the desirability and advantages of modifying Brown in view of Stratigos et al. by showing a status of a preloading message, such as disclosed by Judson, in order to let the user know when the preloading is done so they can proceed to view the preloaded message.

As per claims 5 and 26, Brown in view of Stratigos et al. and in view of Judson further disclose displaying a partial preview of said second electronic mail message (see Judson Fig 5. where a downloading page shows a partial portion of the fully downloaded page [the status bar indicates and unfinished page]); and altering said partial preview in response to a change in status of said step of preloading said second electronic mail message (it is implied as the page continues to download, the partial preview will be altered to include the newly downloaded material).

As per claims 6 and 27, Brown in view of Stratigos et al. and in view of Judson further disclose displaying a preview of second electronic message in a distinct format (see Judson Fig 5. where a downloading page shows a partial portion of the fully downloaded page [the status bar indicates and unfinished page] HTML format).

As per claims 7 and 28 Brown in view of Stratigos et al. and in view of Judson further disclose that status includes the step of displaying at least one graphic element (see Judson Fig. 5, where the graphic element is considered the browser displaying in the bottom left corner the status amount of the page loading).

As per claims 8 and 29, Brown in view of Stratigos et al. and in view of Judson further disclose that status includes displaying text (see Judson Fig. 5. where a page loading indicates the status a percentage of completion).

7. Claims 42 and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Stratigos et al. and in view of Judson as applied to claims 41 and 43 above, and further in view of Jiang et al. Although the system disclosed by Brown in view of Stratigos et al. and in view of Judson shows

Art Unit: 2153

substantial features of the claimed invention (discussed above), it fails to disclose an interrupt mechanism configured to interrupt the download mechanism, responsive to the first input mechanism.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Brown in view of Stratigos et al. and in view of Judson, as evidenced by Jiang et al..

In an analogous art, Jiang et al. disclose that it would have been obvious to have an interrupt mechanism configured to interrupt the download mechanism, responsive to the first input mechanism (see column 3, lines 7-21, where interrupting headers is analogous to interrupting the transmission of the first data frame when a user changes to a second frame before the first frame has been completely transferred).

Given the teaching of Jiang et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Brown in view of Stratigos et al. and in view of Judson by interrupting transmission of a first set of data when a second item is selected, such as disclosed by Jiang et al., in order to change the priority of data before it is completely transmitted (see Jiang et al. columns 2 and 3, lines 66-67 and 1-2).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the

Art Unit: 2153

conflicting application or patent is shown to be commonly owned with this application. See 37

CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.

A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,377,978 in view of Judson et al (US 5,572,643).

Please see the claim mapping below where bold indicates the differences between the US Patent 6,377,978 and the instant application.

Patent US 6,377,978	Instant Application 09/853937
1. A method for presenting electronic mail messages to an operator, including the steps of loading a plurality of headers from a mail server, each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message;	1. A method for presenting electronic mail messages to an operator, including the steps of loading a plurality of headers from a mail server, each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message;
receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded;	receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded;
presenting said first electronic mail message to said operator;	presenting said first electronic mail message to said operator;
identifying a second one of said electronic mail	identifying a second one of said electronic mail



messages for preloading; and preloading said electronic mail message for later presentation, without interrupting presentation of said first electronic mail message;	messages for preloading; and preloading said second electronic mail message for later presentation, without interrupting presentation of said first electronic mail message; and
<b>wherein said step of identifying said second electronic mail message for preloading is responsive to a preference designated by said operator.</b>	<b>presenting to said operator a status of said step of preloading said second electronic mail message.</b>

Although the system disclosed by US Patent 6,377,978 shows substantial features of the claimed invention (discussed above), it fails to disclose presenting to said operator a status of said step of preloading said electronic mail message.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by U.S. Patent No. 6,377,978, as evidenced by Judson.

In an analogous art, Judson disclose presenting to an operator a status of preloading a second electronic message (see column 6, lines 35-39, where the inline message is shown as the hypertext document is being downloaded using the status bar from Fig. 5). In the preferred embodiment, the document in Fig. 5 is preloading as a user is shown a welcome screen shown in Fig 8 (see column 6, lines 12-24).

Given the teaching of Judson, a person having an ordinary skill in the art would have obviously recognized the desirability and advantages of modifying U.S. Patent No. 6,377,978 by showing a status of a preloading message, such as disclosed by Judson, in order to let the user know when the preloading is done so they can proceed to view the preloaded message.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art

Art Unit: 2153

patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).” ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea  
Examiner  
Art Unit 2153

PJC 10/6/05



KRISNA LIM  
PRIMARY EXAMINER